

PATENT

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## IV. Remarks

Claims 1-20 are pending in the present application. Applicant hereby affirms its oral election of Claims 16-20 for prosecution.

As requested by the Examiner, a substitute abstract and title are provided. Withdrawal of the objection to the abstract and title is respectfully requested.

## A. Rejection of Claims 16-20 under § 112

The Action rejects Claims 16-20 under 35 U.S.C. § 112, ¶1 for not providing enablement for applying vacuum pressure to the hot polymeric material through the rotating belt at any other temperature than the hot polymeric material being above its heat deflection temperature. Applicant respectfully disagrees with the Examiner's reading of the disclosure of the vacuum forming step in the Specification. At Paragraph 17, for example, the Specification provides the following:

The extruded sheet 10, made from the preferred PVC composition, preferably remains above its heat deflection temperature while it is being plastically deformed during vacuum forming in the preferred mold impression 11. If the temperature of the polymer drops much below the heat deflection temperature for thermoplastic compositions, vacuum forming becomes impracticable.

(emphasis added). Contrary to the Examiner's contention, the Specification does not require that the hot polymeric material be above its heat deflection temperature, although it is preferred. Therefore, consistent with Section 112, the Specification does provide an enabling disclosure without limiting the claims to a hot polymeric material that is above its heat deflection point. MPEP 2164.08 provides that the claims are enabled if "one skilled in art is enabled to make and use the entire scope of the claimed invention without undue experimentation." Applicant respectfully submits that one of ordinary skill can practice the entire claimed invention without undue experimentation.

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With that said, the "providing" step of Claim 16 has been amended to recite that the hot polymeric material is above its heat deflection temperature, not to comply with the enablement requirements of Section 112, but to clarify that the providing step is consistent with the recited cooling step -- "cooling said patterned central portion below said heat deflection temperature of said polymeric material." Reconsideration and withdrawal of this rejection is respectfully requested.

**B. Rejection of Claims 20 under § 112**

The Action rejects Claim 20 under 35 U.S.C. § 112, ¶1 for not providing enablement for forming the lateral edge portions without the hot polymeric material being above its heat deflection temperature. Applicant respectfully disagrees with the Examiner's narrow interpretation of the disclosure. Paragraph 18 provides the following:

In the preferred embodiment of this method, a pair of lateral edge portions 26 and 27, "C" and "D", are not cooled, but remain at a temperature of about 250°F while the central patterned sheet portion "A" is cooled to about 140°-150°F. This enables the lateral edge portions 26 and 27 to be plastically deformed by mechanical means while still hot.

(emphasis added). Contrary to the Examiner's contention, the Specification does not require that the hot polymeric material be above its heat deflection temperature, although it is preferred. As set forth in Paragraphs 17 and 18 above, it is possible, but not preferred, to plastically deform a hot polymeric article at a temperature below its heat deflection temperature. Therefore, consistent with Section 112, the Specification does provide an enabling disclosure without limiting the claims to a hot polymeric material that is above its heat deflection point. MPEP 2164.08 provides that the claims are enabled if "one skilled in art is enabled to make and use the entire scope of the claimed invention without undue experimentation." Applicant respectfully submits that one of ordinary skill can practice the entire claimed invention without undue experimentation.

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With that said, the "further forming" step of Claim 20 has been amended to recite that the hot polymeric material is above its heat deflection temperature, not to comply with the enablement requirements of Section 112, but to clarify that the further forming step is consistent with the cooling step of Claim 20 -- "cooling said lateral edge portions below said heat deflection temperature to produce a relatively continuous shaped sheet". Reconsideration and withdrawal of this rejection is respectfully requested.

**C. Rejection under the judicially created doctrine of double patenting**

Claims 16 and 20 are rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1 and 10 of US Patent No. 6,319,456 to Gilbert et al. and U.S. Patent No. 4,015,391 to Epstein. Applicant respectfully submits that the Examiner has misconstrued the Epstein reference and/or what the Applicant has claimed.

In the rejection, the Examiner relies on Epstein, FIGS. 2-5, to teach the "beveled feature" recited in Claim 16, i.e., vacuum forming using "said mold impression resembling a plurality of adjacent shingle impressions of substantially the same length, each of said shingle impressions including a bottom edge, at least one of said bottom edges being beveled to give the appearance of shingles having different lengths". This feature is shown in FIGS. 7A-7E of the present application with the beveled feature being shown at reference 202b. FIG. 7E clearly illustrates beveled bottom edge 202b and non-beveled bottom edge 202a from a side view.

Applicant submits that FIG. 3 of Epstein best indicates the shingle impressions of the disclosed simulated cedar shake construction. Epstein does not teach or suggest shingle impressions of substantially the same length where at least one of the bottom edges is beveled to give the appearance of shingles having difference lengths. Rather, Epstein appears to teach shingle impressions that have different lengths. Take for example the top row or course of shingles in FIG. 3. From the left side, the first shingle impression (partial view) and second shingle impressions have the same length, i.e., their bottom edges align. The third, fourth and

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fifth impressions have a different lengths than the first and second shingle impressions. There is no appearance of different lengths provided by bottom beveled edges; rather, the impressions of Epstein actually have different lengths. This conclusion is supported by following the top edge of the overlapped course -- the middle course of shingle impressions shown in FIG. 3. The top edge is a continuous line that runs behind the top course of shingle impressions and can be seen when there are gaps between the impressions. This indicates that the top course overlaps the middle course. The cedar impressions of the middle course of shingles (illustrated by the wavy lines) continue up to the bottom edge of each shingle of the top course. If a bevel were present in the bottom edges of the top course shingle impressions, one would expect the bevel to show up as, for example, an area with no wavy lines near the overlap area. This is not the case. The cross-section views of FIGS. 4 and 9 also do not show any bevels.

Further, Applicant submits that there is no written disclosure in Epstein that provides or suggests the recited bevel feature relied upon by the Examiner. For these reasons, Applicant submits that the Examiner has not made a *prima facie* case of obviousness under MPEP § 2142 because the combination of references does not teach or suggest each claimed feature.

Therefore, Claims 16 and 20 are not obvious from Gilbert et al. in view of Epstein, and are allowable over the art of record. Reconsideration and withdrawal of the rejection is respectfully requested.

**D. Rejection Under 35 U.S.C. § 103(a)**

The Action rejects Claims 16-20 as being obvious from U.S. Patent No. 5,314,325 to Bosler in view of U.S. Patent No. 4,649,008 to Johnstone et al. and Epstein. With respect to independent Claim 16, the Examiner relies on Epstein for providing the beveled bottom edge feature, Johnstone et al. for providing the severing step and Bosler for providing the rest of the process steps. As argued above, Epstein does not teach or suggest the beveled bottom edge

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feature recited in independent Claim 16. Therefore, it is submitted that Claim 16 and Claims 17-20, which depend from Claim 16, are allowable over the cited references.

In addition to the foregoing reasons, dependent Claim 20 is also separately patentable over the cited references. The Examiner relies on FIGS. 1-5 of Bosler for teaching the additional features recited in Claim 20. Bosler, however, clearly does not teach or suggest a process where vacuum pressure is applied to form a patterned central portion and a pair of unpatterned lateral edge portions as recited in amended Claim 20. The method further comprises the steps of (a) further forming at least one lateral edge portion while above said heat deflection temperature, and (b) cooling said lateral edge portions below said heat deflection temperature to produce a relatively continuous shaped sheet.

Claim 20 has been amended to clarify that the lateral edge portions are unpatterned. Referring to FIG. 2 of Bosler, hot plasticized material 10 is extruded and drawn down onto patterned form 22 on belt means 18. (Column 6, Lines 32-54). It appears that the entire extruded sheet is patterned and that no unpatterned lateral edge portions are present that can be further formed. Therefore, Bosler does not teach or suggest forming a patterned central portion and unpatterned lateral edge portions and further forming at least one of the unpatterned lateral edge portions. For the foregoing reasons, it is submitted that Claim 20 is independently allowable over the art of record. Reconsideration and withdrawal of this rejection is respectfully requested.

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## V. Conclusion

In view of the foregoing remarks and amendments, Applicant submits that this application is in condition for allowance at an early date, which action is earnestly solicited.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to Deposit Account No. 04-1769.

Respectfully submitted,

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